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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/778,543
Filing Date: February 07, 2001
Appellant(s): GODLEY, GLENN R.

John D. Gugliotta
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/15/2009 appealing from the Office action mailed 2/27/2009.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,847,120	HICKS	11-1974
5,726,629	YU	3-1998
5,568,792	LYNCH	10-1996
6,354,244	GREEN	3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2, 4, 5, 9, 11, 12, 18, & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hicks (US 3,847,120 A), hereinafter known as Hicks.

Hicks discloses **an apparatus to teach a subject to vocally emulate sounds** (a device for training birds to talk that includes a recording playback unit that repeats spoken sounds, 1:49- 51) **comprising: a housing comprising an front portion and a back portion** (The device includes a suitable housing having a front side panel and mounted for pivotal movement adjacent the rear of the device on the extensions, 2:53-3:14; see also Figure 1, Items 11, 12, & 16); **a presence detecting sensor located at said front portion for detecting the presence of said subject** (One side of the perch is operative to cooperate with a microswitch positioned along the bottom of the device. A lever projecting from the microswitch forms the interconnecting means of the two parts. As will thus be clear, when a bird flies up and alights on the perch, said perch is depressed and the lever is pivoted in the downward direction, 2:62-3:14); **a system for playing back a predetermined message, located at said back portion** (switching action in the switch activates the tape playback unit and causes sounds to emanate from a speaker positioned directly behind the front panel, 2:62-3:14; also, there is shown a view of the device with the front panel removed, so as to reveal tape playback unit, 3:28-36; the rear portion is understood to be directly behind the front portion), **wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor** (the lever controls the switch, and thus starts and stops

the tape playback unit. The lever is pivoted upwardly by a spring which thus in turn supports the weight of the perch. The spring is calibrated so that the weight of the bird on the perch moves the lever so as to switch the switch from the "off" position to the "on" position, 3:67-4:5); **a mirror affixed to said front portion** (housing having a front side panel having full-size mirror that may be removable, 2:53-61); and **a perch assembly coupled to a lower portion of said housing** (a perch that is generally U-shaped and mounted for pivotal movement adjacent the rear of the device on the extensions, 2:62-3:14; as in Figure 1, Items 15 & 16, the perch extensions are understood to be on the lower portion of the housing) [Claims 1 & 19].

Hicks also discloses **a method of teaching a subject to vocalize sounds** (an improved bird training device has been disclosed that is highly efficient in teaching a bird to talk, 4:35-38) **comprising: selecting a prerecorded sound to be played back by a playback system** (front side panel is removable to expose the inside components [including the playback system] for changing of the record, 2:53-61); **detecting said subject's presence by a presence detecting sensor** (1:63-2:8 & 2:62-3:14); **and upon the sensor's detection of said subject, the prerecorded sound is played back for said subject to hear** (3:67-4:5), **whereby said subject learns to vocally emulate a desired sound** (when the spoken words are reproduced through the playback unit, the bird is likely to mimic the bird of the reflection and begin to repeat the phrases recorded on the record means, 2:5-8) [Claim 18].

Hicks discloses **recording sounds that are audible to animals** (2:5-8; a bird is understood to be an animal) [Claim 4].

Hicks **discloses wherein said presence detecting sensor comprises a movement sensing device** (perch is mounted for pivotal movement, 2:62-3:14) [Claim 5].

Hicks discloses **a bird perch for holding a bird** (a bird is encouraged to sit on the perch, 1:63-2:8) [Claim 9].

Hicks discloses **a mirror** (2:53-61) [Claim 11], **contained within said housing** (2:53-61), **and providing visual stimulation to said subject** (When the bird sees his full reflection in the mirror, [his] excitement encourages the bird to perform, 2:3-5) [Claim 12].

Claims 1, 4, 5, 8, & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu (US 5,726,629 A), hereinafter known as Yu.

Yu discloses **an apparatus** (an electrical illumination and sound device, 1:32-35; the limitation, "to teach a subject to vocally emulate sounds" is merely an intended use of the apparatus, stated in the claim preamble, and thus no given patentable weight herein; see MPEP 2111.02.11) **comprising: a presence detecting sensor for detecting the presence of a subject** (motion detector; When a person or an object such as a motor vehicle enters into an area monitored by the motion detector, the invisible infrared heat radiation emitted by the moving person or object is detected by the infrared sensor of the motion detector, 1:37-44); **a system for playing back a predetermined message** (announcement device, 1:37-44), **wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor** (1:37-44); **and a housing which contains said sensor and said playback initiation system** (The lighting fixture comprising an illumination device such as a light bulb, a motion detector, and an announcement device are assembled together within the body of the lighting fixture and formed integral pans [sic] of the lighting fixture, 2:6-25) [Claim 1].

Yu discloses **recording sounds that are audible to animals** (the announcement device is a sound recording and playback device similar to the one used in a telephone answering machine; the announcement can be prerecorded messages by manufacturer such as a dog's barking to scare away stranger, a verbal warning to outside intruder, a short tune of

music, a welcome greeting to visitor or guest etc. If a user requires a personalized announcement or message, he or she can record his or her own announcement in the announcement device, all at 2:48-60; the announcement is audible to humans, who are organisms of the kingdom *Animalia*) [Claim 4].

Yu discloses **wherein said presence detecting sensor comprises a movement sensing device** (a motion detector, 1:37-44) [Claim 5].

Yu discloses **wherein said presence detecting sensor for detecting the presence of said subject comprises a heat sensing device** (the invisible infrared heat radiation emitted by the moving person or object is detected by the infrared sensor of the motion detector, 2:6-25) [Claim 8].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks, in view of Lynch (US 5,568,792 A), hereinafter known as Lynch.

Hicks teaches **a system for selecting a prerecorded sound to be played** (by changing the record, 2:53-61). What Hicks fails to teach is wherein said system comprises **a selector switch for choosing a desired prerecorded sound** [Claim 2]. However, Lynch teaches a training device for teaching a bird to recite words, sounds or music, having a digital recording and playback device for recording and playing a desired message (Abstract). Lynch further teaches using a test/record switch located on the face of the enclosure to select a message for recording (5:12- 29). Because the switch enables the recording mode of the device, it is understood to be a selector switch. A switch such as this would merely be included in the device of Hicks for enabling recording of the magnetic tape, such that a user may selectively determine what message to teach to a bird. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the selector switch taught by Lynch to select a recording to be played to a bird in the device of Hicks, in order to adjust the message to be played if a pronunciation error or other undesirable sound occurred at the time of recording [Claim 2].

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks, in view of Yu.

Hicks teaches all the features of claim 1 as demonstrated above, including **a presence detecting sensor for detecting the presence of said subject** (2:62-3:14). What Hicks fails to teach is **wherein said presence detecting sensor comprises a light sensing device** [Claim 6] or **a laser and a laser detection sensor** [Claim 7] for detecting the absence of light due to the presence of said subject. However, Yu discloses wherein said presence detecting sensor for

detecting the presence of said subject comprises a heat sensing device motion detector (1:37-44) [Claim 8]. Applicant has further not disclosed that using a light sensor or a laser sensor solves any new stated problem or is for any unexpected particular purpose, over a mechanical sensor, a light sensor, a laser sensor, or a thermal sensor. Moreover, it appears that the motion detector of Yu, the mechanical level of Hicks, or the Applicant's instant invention would perform equally well for detecting the presence of a subject, so that an output requiring close proximity of the subject may be employed. It is further disclosed in applicant's specification that a sensor having a particular type of presence detector is optional design choice (see specification, page 4, lines 12-20). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the bird feeder of Hicks to use a non-mechanical sensor, as taught in Yu, in order to monitor an area in proximity to the device; also, to implement the sensor as either a light, laser, or thermal sensor, because such a modification would have been considered a mere design choice, because such well-known types of motion detectors would have been considered equivalents in the art, interchangeable and all used for the same purpose of detecting the presence of a subject, and thus the modification fails to patentably distinguish over Hicks and Yu [Claims 6 & 7].

Claims 10 & 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks, in view of Green US 6,354,244 A), hereinafter known as Green. Hicks teaches all the features of claims 1 & 9 as demonstrated above, including **a bird perch** (1:63-2:8). What Hicks fails to teach is **wherein said bird perch is detachable** [Claim 10] and **a trough, inserted within a space formed within said bird perch** [Claim 16]. However, Green pertains to garden accessory systems, specifically, planters, birdfeeders, birdhouses, bird perches, and other objects that may be hung or fixed in outdoor locations (1:17-22). Green teaches the design of

bird feeder accessories (generally at 10:40-17:58), including single- and double-hopper feeders (10:47-56; see also Figures 13A & B; bird feeders are known to have a trough inserted therein, for dispensing different bird's feed). Green further explains (11:61-67) that both feeders have removable perches, for preventing larger birds from dominating the feed tray. Any bird feeder accessories, such as those taught by Green, would have been obvious upgrades to the bird training device of Hicks; indeed, both Green's bird feeders and Hick's bird trainer are intended to attract particular *genera* of birds. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added well-known accessories for bird feeders, such as the hoppers or detachable perch taught by Green, in the bird trainer of Hicks, in order to attract mimicking birds only [Claims 10 & 16].

What Hicks further fails to explicitly teach is **a means for attaching said apparatus to a birdcage** [Claim 13], comprising a bracket [Claim 14], or **wherein said apparatus is capable of freely standing** [Claim 15]. However, Green also teaches attaching a birdbath to a free-standing pole using brackets as a mounting assembly (Figure 1 B, Item 24; 15:53-16:4; also, Figures 23A- C). It is further disclosed in applicant's specification that having the device mounted vs. free standing is, in fact, optional design choice (see specification, page, 7 line 21 through page 8, line 2; also, page 5, lines 14-16). The bird trainer of Hicks would obviously be either mounted to an outdoor fixture or pole, using brackets as taught by Green, or be free standing, as would be used indoors, for training pet birds, where indoor furniture makes such mounting unnecessary. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, and in view of the prior art and common sense, to have mounted the bird trainer of Hicks using brackets, or have left it free-standing, as taught in Green, in order to impart flexibility of indoor or outdoor use to the device [Claims 13-15].

(10) Response to Argument

(a) Claims 1, 2, 4-5, 9, 11, 12, 18, and 19 are properly rejected under 35 U.S.C.

§102(b) as being anticipated by Hicks.

With regard to appellant's arguments that the mechanical lever in the Hicks reference is not a sensor, according to Webster's New Riverside Dictionary, a *sensor* is a device that detects and responds to a signal or stimulus. By this definition, the mechanical lever that a bird sits upon, when then depresses a switch to close a contact and initiate a playback device, does constitute a sensor. As such, the Hicks reference does disclose a sensor, of a mechanical type, sensitive to a bird's weight, and therefore does disclose this element. Appellant also presents the argument that Hicks does not anticipate the initiation of the system for playback when the detachable bird perch is removed. This argument is unpersuasive because applicant's claims do not recite where the system must allow initiation and operation while the bird perch is detached from the system. The combination of claims 1, 9, and 10 at most presumes an operational playback device with a presence detecting bird perch, wherein said bird perch is detachable. The combination set forth in said claims is anticipated by Hicks, and thus is properly rejected under §102(b).

(b) Claims 1, 4, 5, 8, and 19 are properly rejected under 35 U.S.C. §102(b) as being anticipated by Yu.

With regard to appellant's argument that the motion detector disclosed by Yu is not a presence sensor, examiner's position is that Yu's motion detector is a movement sensing device within the specific scope of Claim 5. Thus, Yu's motion detector anticipates the claims because they equate a movement sensing device, such as Yu's, with a presence sensor. Appellant presents the argument that a presence detector is distinct from a motion detector and that the prior art would not detect presence from a motion detector. However, in the instant case there is

no functional difference between a motion detector and a presence detector. The training device is stationary, thus there is no means for a bird, child, or other subject to find itself upon the perch except through *moving* through the field of motion detection in the front of the device. The motion detection field is easily tuned to extend an active radius no further out than the bird perch, thus detecting the presence of the bird. Appellant further admits in his specification, at page 2, lines 19-20 that his sensor may be initiated by movement. Functionally, this is the same performance required of the presence detector in the instant invention; thus Yu does anticipate the invention, and is properly rejected under §102(b).

(c) Claim 2 is properly rejected under 35 U.S.C. §103(a) as being unpatentable in view of Hicks and Lynch.

With regard to appellant's argument that there is no suggestion or motivation to the desirability to adapt the bird training device of Hicks with a selector switch with the selector switch for choosing a desired prerecorded sound, Lynch teaches allowing a user to choose to play back a prerecorded sound to a bird; allowing control of the playing of a desired sound for a predetermined number of times and intervals. A switch such as this would merely be included in the device of Hicks for enabling recording of the magnetic tape, such that a user may selectively determine what message to teach to a bird, as explicitly taught by Lynch at 2:7-19. Therefore, examiner's position is that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the selector switch taught by Lynch to select a recording to be played to a bird in the device of Hicks, in order to adjust the message to be played if a pronunciation error or other undesirable sound occurred at the time of recording. A proper *prima facie* case of obviousness has therefore been demonstrated; thus, the claim is correctly rejected under 103(a).

(d) Claims 6-8 are properly rejected under 35 U.S.C. §103(a) as being unpatentable in view of Hicks and Yu.

With regard to appellant's argument that Hicks fails to teach any of a light-sensing device, a laser and laser-detection sensor, or a heat-sensing device, and thus has not met the burden of evidence, examiner notes that Yu teaches a presence detector, such as a motion detector, for transmitting an electronic signal when a person or an object such as a motor vehicle enters into an area and is detected, which causes the lighting fixture to turn on and at the same time causes playback of an announcement (Column 1, Lines 37-42). Examiner recognizes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Additionally, the Supreme Court has particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," where, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. 398, 82 USPQ2d at 1385 (2007); also MPEP 2142 (Rev. 6, Sept. 2007). The focus when making a determination of obviousness is on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have been reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. In this case, Yu's motion detector is *prima facie* evidence that it was old and well-known at the time of invention that a motion detector may be used for detecting the presence of a

person or other object, in order to shine a lamp and play an announcement when the person or object approaches within sight or hearing range. Examiner's position is further that other old and well-known presence sensors, light-sensing devices (e.g., photo-electric eyes), laser-detection sensors (e.g., LIDAR, laser range finders), or heat-sensing devices (e.g., infrared cameras), would merely be substituted for the motion detector in Yu in order to perform their well-established function of triggering a switch when a given sensor-specific threshold is reached, caused by the proximity of a bird, child, or other subject; thus simply substituting one known presence sensor for another in Yu's invention, to obtain predictable results. Thus, examiner's position is that mere substitution of any of a light-sensing device, a laser and laser-detection sensor, or a heat-sensing device for the motion detector of Yu is not patentably distinguishing over the invention of Hicks; thus, the claims are properly rejected under §103(a).

(e) Claims 10 and 13-16 are properly rejected under 35 U.S.C. §103(a) as being unpatentable in view of Hicks and Green.

With regard to appellant's argument that Green has an issue date of March 12, 2002, more than a year after the filing date of appellant's invention, examiner notes that the Green patent was filed in the United States on September 16, 1999; thus Green constitutes proper prior art under 35 U.S.C. §102(e) (pre-AIPA) which states that: a person shall be entitled to a patent unless- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent....before the invention thereof by the applicant for patent.

U.S. patents may be used as of their filing dates to show that the claimed subject matter is anticipated or obvious. Obviousness can be shown by combining other prior art with the U.S. patent reference in a 35 U.S.C. §103 rejection. *Hazeltine Research v. Brenner*, 382 U.S. 252,

147 USPQ 429 (1965); see also MPEP 2136.02(III). Thus, Green is proper prior art in a §103 rejection.

With regard to appellant's argument that Green constitutes nonanalogous art because it discloses a garden accessory system, examiner notes that it is unclear if appellant is arguing that Green is not analogous to his invention or Hick's. Green purports to invent improvements to birdfeeders, birdhouses, bird perches, and other objects that may be hung or fixed in outdoor locations, at 1:17-22, and teaches the design of bird feeder accessories at 10:40-17:58. Green teaches a bird feeder trough at least in Figures 13A and 14A. It has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, appellant's art is the design of bird accessories; specifically where Green's bird perch is intended for mounting is irrelevant to his intention to produce accessories for birds and solve problems associated with bird perches. Green treats both the problems associated with mounting the perch is a desirable location, as well as removing perches to discourage bigger birds; thus, Green is understood to be both in the same field of endeavor as the instant invention and concerned with typical problems with bird enclosures; thus, Green, Hicks, and appellant's invention are considered analogous to the field of endeavor of bird accessories, and solve problems concerned with mounting and adapting bird perches for particular types of birds; thus the rejection under §103(a) is proper.

Art Unit: 3715

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nikolai A Gishnock/

Examiner, Art Unit 3715

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